

REMARKS

In the Final Office Action, the Examiner rejected claims 1-26 and 33-37. Applicant respectfully traverses the rejections. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims (i.e., claims 1-26 and 33-37).

Rejections under 35 U.S.C. § 102

In the Final Office Action, the Examiner rejected claims 1-26 and 33-37 under 35 U.S.C. § 102(e) as anticipated by the Brownlee reference (U.S. Patent No. 6,282,303; hereinafter "Brownlee"). In rejecting independent claims 1, 9, 17, 22, 23, and 26, the Examiner stated as follows:

Regarding claim 1, Brownlee discloses that [sic] the claimed feature of a user input device comprising: a fingerprint scanner [i.e. "transparent roller"; 920, to acquire a fingerprint of user; See col 4 line 44-45]; and a driver operably coupled to the fingerprint scanner to enable the fingerprint scanner [920] to perform a function, wherein the function comprises at least one of a zoom function ["zooming wheel"; 920, See col 4 line 54, col 10 line 48-49] and a hot-key function. (See Abstract, Fig 1-3, Fig 9-11, col 1 line 46-47.)

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Regarding claim 9, refer to the discussion for the claim 1 hereinabove, Brownlee discloses that [sic] the claimed feature of a computer system comprising: a processor [601]; a fingerprint scanner [902] operably coupled to the processor [601]; and a driver to configure the fingerprint scanner to perform at least one of a zoom function ["zooming"], and a hot-key function. (See Abstract, Fig 1-3, Fig 9-11, col 1 line 46-47.)

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Regarding claim 17, refer to the discussion for claim 1 hereinabove, Brownlee discloses that the claimed feature of a method of operating a fingerprint scanner [902] comprising the acts of: (a) configuring a computer to perform at least one of a zoom ["zooming"] function and a hot-key function in response to signals generated by the fingerprint scanner; and (b) generating signals based on input to the fingerprint scanner wherein the input to the fingerprint scanner comprises at least one of a unique image and motion. (See Fig 2, Fig 4, Abstract, col 3 line 39-48.)

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Regarding claim 22, refer to the discussion for the claim 1 hereinabove, Brownlee discloses that [sic] the claimed feature of a method of manufacturing a computer system comprising the acts of: (a) providing a fingerprint scanner [902]; (b) providing a processor [601]; (c) operably

coupling the fingerprint scanner to the processor; and (d) providing software that configures the processor to interpret signals from the fingerprint scanner as at least one of a zoom function and the hot-key function. (See Fig 1, Fig 2, Fig 4, Abstract, col 3 line 39-48.)

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Regarding claim 23, Brownlee discloses that the [sic]claimed feature of method a method [sic] of using a fingerprint scanner configurable to control one of a zoom function and a hot-key function, the method comprising the act of: moving a finger on the fingerprint scanner to cause the one of zoom function and a hot-key function. (See Abstract, Fig 2.)

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Regarding claim 26, refer to the discussion for the claim 1 hereinabove, Brownlee discloses that [sic] the claimed feature of a computer system comprising: means for configuring a computer to perform at least one of a zoom function and a hot-key function in response to signals generated by the fingerprint scanner; and means for generating signals based on input to the fingerprint scanner wherein the input to the fingerprint scanner comprises at least one of a unique image and motion. (See Fig1, Fig 2, Fig 4, Abstract, col 3 line 39-48.)

Final Office Action mailed November 16, 2004, pp. 2-8.

Applicant, respectfully traverses the Examiner's rejections. Applicant respectfully asserts that Brownlee does not disclose all of the features recited in independent claims 1, 9, 17, 22, 23, and 26. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *See Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *See In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the *identical* invention "in as complete detail as contained in the ...claim" to support a *prima facie* case of anticipation. *Richardson V. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicant needs only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

Additionally, Applicant reminds the Examiner that, during patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. *See In re Prater*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *see also In re Morris*, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. In developing a reasonable interpretation of a claim term, the words of the claim must be given their plain meaning unless the applicant has provided a clear definition in the specification. *See In re Zletz*, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989). Moreover, interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111. Accordingly, the plain meaning refers to an interpretation by those of ordinary skill in the art. *See In re Sneed*, 218 U.S.P.Q. 385 (Fed. Cir. 1983).

Independent Claims 1, 9, 17, 22, 23, and 26 and the Claims Depending Therefrom

Each of the independent claims of the present application recites, in various permutations and combinations, a driver, a computer component, and/or software capable of performing functions in cooperation with a fingerprint scanner, wherein the functions comprise at least one of a zoom function and hot-key function. Specifically, the independent claims in the instant patent application recite as follows:

Claim 1: “a driver operably coupled to the fingerprint scanner to enable the fingerprint scanner to perform a function, wherein the function comprises at least one of a zoom function and a hot-key function;”

Claim 9: “a driver to configure the fingerprint scanner to perform at least one of a zoom function and a hot-key function on the computer;”

Claim 17: “configuring a computer to perform at least one of a zoom function and a hot-key function in response to signals generated by the fingerprint scanner;”

Claim 22: “providing software that configures the processor to interpret signals from the fingerprint scanner as at least one of a zoom function and a hot-key function;”

Claim 23: “moving a finger on the fingerprint scanner to cause the one of a zoom and a hot-key function;” and

Claim 26: “means for configuring a computer to perform at least one of a zoom function and a hot-key function in response to signals generated by the fingerprint scanner.”

(Emphasis added.) Respectfully, Applicant asserts that Brownlee does not, at a minimum, disclose all of the above-recited features, particularly those features highlighted above.

Prior to addressing the substance of Brownlee, Applicant clarifies the recitation “a least one of a zoom function and a hot-key function,” as presented in the above-quoted claims. As used in the present application, Applicant asserts that the above-quoted recitation encompasses a device or component having both zoom functionality and hot-key functionality. Indeed, the Federal Circuit has held that the use of the phrase “at least one” in conjunction with the term “and” by its ordinary meaning indicates a conjunctive list, requiring that the phrase “at least one of” modify each member of the list, i.e., each category in the list. *See SuperGuide Corp. v. DirecTV Enterprises Inc.*, 69 U.S.P.Q.2d 1865, 1876 (Fed. Cir. 2004). Thus, in the present application, the above-quoted independent claims encompass a device or component having at least one zoom function and at least one hot-key function.

With this in mind, Applicant respectfully asserts that Brownlee fails to disclose the hot-key functionality recited in independent claims 1, 9, 17, 22, 23, and 26. Indeed, a careful review of the sections of Brownlee cited by the Examiner establishes that hot-key functionality is neither taught nor suggested.

In fact, the Examiner’s rejection fails even to address the recited hot-key functionality. As exemplified by the Examiner’s above-quoted rejection of claim 1, no citation to a section of Brownlee is provided for hot-key functionality. *See* Final Office Action mailed November 16, 2004, pp. 2-3. However, the Examiner does provide a specific citation to the section of Brownlee that allegedly discloses the recited zoom function. *See id.* Keeping in mind the Examiner’s obligations of specific citation under 37 C.F.R. § 1.104(b), the lack of citation correlating Brownlee to the claimed “hot-key” function demonstrates that the Examiner rejected the above quoted independent claims solely on the Examiner’s belief that Brownlee

discloses a zoom function. That is, Applicant respectfully asserts that the Examiner did not even address the recited hot-key function in the Final Office Action.

Accordingly, Applicant respectfully asserts that the Examiner's rejection is insufficient to support a *prima facie* case of anticipation and that Brownlee does not anticipate independent claims 1, 9, 17, 22, 23, and 26 and the claims depending respectively therefrom in any event. With the forgoing in mind, Applicant respectfully requests reconsideration and allowance of claims 1-26 and 33-37.

Brownlee Fails to Disclose Features Recited in the Dependent Claims

Additionally, Applicant respectfully asserts that Brownlee fails to disclose all of the features recited in the presently pending dependent claims. The dependent claims discussed below merely exemplify features recited in the dependent claims of the present patent application that are not found or suggested by Brownlee.

For example, Brownlee does not disclose a user input device in which the fingerprint scanner is disposed on a PCMCIA card, as is recited in dependent claim 5, nor does Brownlee disclose a USB interface as recited in claim 6. In rejecting these claims, the Examiner stated: "Regarding claim 5, Brownlee discloses that the fingerprint scanner is disposed on a PCMCIA card. (See Fig 6)" and "Regarding claim 6, Brownlee discloses that the fingerprint scanner comprises a USB interface. (See Fig. 6.)" *See* Final Office Action mailed November 16, 2004, p. 3. However, Fig. 6 of Brownlee illustrates a block diagram of various components of an embodiment of the Brownlee device, and none of these illustrated components is a PCMCIA card or a USB interface. Indeed, Fig. 6 of Brownlee is only discussed within Brownlee at column 4, lines 14-36, and review of this section clearly demonstrates that neither PCMCIA cards nor USB interfaces are taught or suggested. Accordingly, Applicant respectfully asserts that Brownlee does not disclose the recited features of dependent claims 5 and 6.

As another example, Applicant respectfully asserts that Brownlee does not disclose the act of "pressing an alternate select key to configure the computer to perform at least one of the zoom function and hot-key function," as recited in dependent claims 19 and 24. In

rejecting these claims, the Examiner stated: “Regarding claim 19, Brownlee discloses that [sic] the act of pressing an alternate select key to configure the computer to perform at least one of the zoom function and a hot-key function. (See Fig 1, Fig 2, Fig 4, Fig 11, Abstract, col 3 line 39-48.)” and “Regarding claim 24, Brownlee discloses that [sic] the act of pressing an alternate select key while simultaneously placing a finger on the fingerprint scanner. (See Fig 1, Fig 2, Fig 4, Fig 11, Abstract, col 3, lines 39-48.)” Final Office Action mailed November 16, 2004, pp. 6 and 7. Beginning with the Examiner’s citation to Figs. 1, 2, 4, and 11 of Brownlee, Applicant respectfully asserts that none of these figures illustrate the above-quoted act. Rather, each of these figures merely illustrates various structural embodiments of the Brownlee device. See Brownlee, col. 2, ll. 7-15 (providing a description of the drawings). Nothing in these device illustrations teaches or suggests the specific act recited in the instant claims.

Additionally, Applicant respectfully asserts that nothing in the text of Brownlee suggests or teaches the act of pressing an alternate select key as is recited in the instant claim. Rather, the Abstract merely provides a general description of the Brownlee device and its believed ability to scan a finger and detect rotation of a roller. See Brownlee, Abstract. Furthermore, nothing in the cited section of Brownlee’s Detailed Description (i.e., col. 3, ll. 39-48) either teaches or suggests the act of pressing an alternate select key as recited in the instant claim. Rather, this cited section merely states that the Brownlee device includes a linear imaging device and a mechanism to detect rotational movement of the roller. See *id.* at col. 3, ll. 39-48. Again, nothing in the forgoing cited sections of Brownlee teaches or suggests the specific act of pressing an alternate select key as recited in the instant claim.

As yet another example, Brownlee fails to disclose the act of tapping the fingerprint reader as recited in dependent claims 20 and 25. Rather, in stark contrast, Brownlee discloses a device in which all activity is conducted by actuating a roller 203. See Brownlee, Fig. 1; col. 3, ll. 10-16. Indeed, the portion of Brownlee cited by the Examiner as being anticipatory of the recited features of claim 20 and 25 states that the invention of Brownlee incorporates “a rotation detector mechanism to detect rotational movement of the transparent roller.” *Id.* at col. 3, ll. 42-45 (emphasis added). Thus, it is clear that Brownlee teaches rotational movement that requires continuous contact with the roller for functionality. Accordingly,

Brownlee not only fails to disclose the act of tapping as recited in the instant claims, but Brownlee discloses a devices whose operation is wholly antithetical to the subject matter of claims 20 and 25. Thus, Applicant respectfully asserts that Brownlee does not disclose the features recited in dependent claims 20 and 25.

Based on the foregoing, Applicant respectfully asserts that the dependent claims of the present application are patentable not only by virtue of their dependence on an allowable base claim, but also by virtue of the additional features recited therein. With the foregoing in mind, Applicant respectfully requests reconsideration and allowance of dependent claims 2-8, 10-16, 18-22, 24, 25, and 33-37.

Conclusion

In view of the remarks set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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